

**IN THE DRAWINGS**

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Please amend FIG. 18 so that FIG. 18 corresponds to the detailed specification. A redlined copy of the proposed amendment to FIG. 18 is enclosed along with a clean copy of FIG. 18 as amended.

### **REMARKS**

In response to the Advisory Action mailed November 21, 2005 and the Office Action mailed September 7, 2005, each one of the cited references has been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the above-identified application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claim 25 has been cancelled without prejudice and new claims 32-39 have been added.

### **New Claims**

New claim 32 is an independent claim that is similar to claim 1 but broader in scope. New claims 33-39 depends from new base claim 32 and are directed to providing a decorative pad as specified in claim 32 with a decorative textured finish as well as a protective shell. In this regard, claim 33-39 are directed to the same subject matter covered by claim 1 as previously presented. No additional fees are required for the added claims.

### **Drawing Amendment**

Applicant respectfully requests that FIG. 18 be amended so that it corresponds to the specification. In this regard, the specification provides at paragraph 0028 which provides a two-sided acrylic pressure sensitive transfer tape 17 on the top surface 12, and a layer of MSC 5527 acrylate adhesive 14 (a polyurethane backing with acrylate adhesive may be obtained from 3M Healthcare as MSX5527 acrylate polyurethane 1.2 mil tape), and a peel sheet 18 protecting the adhesive until ready to use. In addition, at

paragraph 0032, it provides, "the adhesive selected should be of sufficient strength to hold pad 10 onto the bottom of foot 1...It is desirable that the adhesive selected be waterproof as well as compatible with the skin of the bottom of the foot."

Finally with reference to FIG. 18 four distinct and separate elements can be seen in the following order: a pad (10) having a bottom surface (13) and a top surface (12); a transfer tape (17) composed of a polyurethane backing sandwiched between two layers of pressure sensitive adhesive; a polyurethane backing supporting an acrylate adhesive (14); and a peel sheet (18).

In further support for this amendment to FIG. 18, applicant has provided a Rule 132 declaration which includes data sheets for the above described transfer tapes and adhesives.

In view of the foregoing, applicant respectfully requests that the red-lined drawing of FIG. 18 be approved and that the clean copy of FIG. 18 as amended be entered and allowed.

#### Election/Restrictions

Attorney for applicant traverse the newly imposed election restriction on the following grounds. Claims 22-24, 26 and 28-29 are dependent claims which depend from claim 1, which the examiner in the Office Action dated December 9, 2004 indicated was a generic claim. Accordingly, if the base claim 1 is a generic claim then each of its dependent claims are in a like-manner generic and are not directed to a non-elected invention.

MPEP 821.03 and 37 CFR 1.142(b) are not applicable to dependent claims 22-24, 26 and 28-29 since these claims as noted above depend from claim 1, which has been declared by the examiner to be a generic claim in the Office Action dated

December 9, 2004.

Based on the foregoing, applicant respectfully request that the examiner reconsider her position with respect to her assertion that claims 22-24, 26, and 28-29 are directed to a non-elected invention.

Claims 30-31 have been withdrawn.

#### **Specification Corrections**

The examiner has objected to the specification stating that it fails to provide a proper antecedent basis for the claimed subject matter. In this regard, the examiner has state that the amendment in claim 1 detailing the "planar body" is not supported in the specification. Attorney respectfully disagrees with the examiner on the following grounds.

The specification which includes the drawings clearly illustrates in the figures that pad has a "flat" or "planar" body engaging surface. In this regard, the common meaning of the word "planar" means "flat". (See the Random House College Dictionary of the English Language, Unabridged Edition). In short then, what is obvious from the drawings need not be specifically stated in the specification.

The examiner has further objected to claims 13 and 25 as having the same limitations. Responsive to this objection, claim 25 has been canceled without prejudice.

## **Rejections**

### **Double Patenting Rejection**

Claims 1, 5, 13, and 15-18 have been rejected on the judicially created doctrine of obvious double patenting over claims 1-12 of U.S. patent application No. 10/454,236 and 09/910,641. Responsive to this rejection, attorney for applicant(s) agrees upon receiving Notice of Allowability with respect to the present patent application, a terminal disclaimer in compliance with 37 CFR 1.32 (c). Accordingly claims 1, 5, 13, and 15-18 will be placed in condition for immediate allowance upon the filing of such a disclaimer.

Attorney for applicant therefore respectfully requests that this rejection be withdrawn conditioned upon the receipt of the above-mentioned terminal disclaimer

### **Rejection Under 35 USC §112**

Claim 1 has been rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. In this regard, the examiner has stated that there is no support in the disclosure that "the attachment engaging surface is covered throughout with a layer of either hook or piles". Attorney for applicant respectfully traverses on the following grounds:

The specification which includes the drawings illustrates FIG. 14 that "the attachment engaging surface of the bottom surface 63 of the pad 65 is completely covered with a layer of "thistle cloth" which is another way of saying hooks or piles, which in turn is a way of describing "Velcro". The following will demonstrate:

Velcro is a registered trademark describing a specific brand of 'hook and loop fasteners'. The product name has proven so popular, however, that it has become the generic term for any two piece fastener with nylon hooks on one side and a mat of loops on the other. Velcro has become very popular in the clothing, shoe, and automotive industries (among others) for its ability to provide a firm grip under tension but come apart easily when necessary.

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The story of Velcro begins with a hike in the Swiss woods in 1948. Inventor George de Mestral noticed that he and his dog were coated with cocklebur seed casings. A cocklebur is any composite plant, comprising coarse weeds with spiny burs, otherwise called a thistle. Under a microscope, de Mestral discovered that the seed casings contained numerous tips with hook-shaped ends. It was these natural hooks which clung so stubbornly to the loose weave of his pants and the dog's fur. George de Mestral believed that a fastening device made from a similar hook and loop design could rival the metal zipper in popularity and versatility.

After several attempts to create a suitable prototype, de Mestral and a French fabric designer finally discovered a way to use nylon fibers under an infrared lamp to create the necessary hooks. Matted nylon fibers would also form the field of loops needed to complete the adhesive process. The name VELCRO was formed from the French words VELour(velvet) and CROchet(hook). De Mestral officially formed the Velcro company in Switzerland in the early 1950s and received patents from virtually every industrialized country in the world.

Velcro works on the principle that enough hooks on one side of a fastener would become tangled in enough loops to form a very strong bond. Applying pressure to a section of Velcro can only make it stronger as more loops and hooks connect. Yet if only a few hooks and loops are pulled apart with force, the rest of the Velcro will follow with a distinctive ripping sound. Velcro sections held under tension, such as a pulley system, can prove to be incredibly strong. This is why shoe manufacturers often place slots through which Velcro closers are pulled. The added tension of a pulley keeps the Velcro bond strong.

Velcro is also popular in the clothing industry. Waistbands in costumes, skirts and pants can be easily adjusted with Velcro fasteners or "thistle cloth". Costumes with Velcro fasteners can be torn away from the body quickly between scenes. Other industries use Velcro strips to store tools or attach fiberglass parts to frames. Large patches of Velcro can easily support hundreds of pounds. Wallets and backpacks, on the other hand, may only need a small patch of Velcro to keep flaps and sections secure. Practically everyone can find at least one product in their homes or cars which use some form of Velcro brand hook and loop fasteners.

Since the drawings specifically illustrate the surface being completely covered, there was no need for the applicant to specify this obvious observable fact. It was sufficient for the applicant to state that the surface was at least partially covered. Moreover, since the specification provides "thistle cloth 93 at least partially covers inner surface 94 and engages complimentary thistle clothe 66 on bottom surface 63 of pad 60, it would be clearly understood by one skilled in the art that such a configuration of thistle cloth

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would be the same as hooks and piles.

If the case can be advanced to allowance, attorney for applicant would, as a condition for allowance, change the claim language to "wherein said attachment engaging surface is at least partially covered with attachment means for providing said pad with a decorative textured finish."

Based on the foregoing, attorney for applicant respectfully requests that this rejection by the examiner be withdrawn.

### **Rejections Under 35 USC §103**

Claims 1, 5, 13-14, 15, 18, and 21 have been rejected under 35 USC §103(a), as being unpatentable over *Porcellii* (U.S. 5,678,273). Claim 1 as previously presented specifies amongst other things, as follows:

- "1. A novelty fashion wear item, comprising:
- a flexible pad having a planar body engaging surface and an attachment engaging surface;
  - wherein said planar body engaging surface is coated throughout with reusable adhesive means for removably securing said pad to a body part; and
  - wherein said attachment engaging surface is covered throughout with a layer of either hooks or piles for providing said pad with a decorated textured finish."

Nowhere is this combination of elements described in, nor suggested by the *Porcellii* (U.S. 5,678,273) hereinafter simply referred to as the *Porcellii reference*.

The *Porcellii reference* describes a disposable oral hygiene applicator attachable to the ball of a user's finger tip whose finger then functions as an articulated handle which the applicator may be inserted in the oral cavity and applied omnidirectionally to the teeth and to massage the gums of the user.

Applicant respectfully asserts that the examiner has not stated a proper *prima facie* case of obviousness in support of the rejections of claims 1, 5, 13-14, 15, 18, and 21 for the following reasons. According to the Manual for Patent Examining Procedure (MPEP) § 2142, a proper *prima facie* case of obviousness can be established only when all of three basic criteria ("prongs") are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).

In rejecting claim 1, 5, 13-14, 15, 18, and 21 for alleged obviousness over the *Porcellini reference*, the examiner has not met the legal requirements cited in *In re Vaeck, supra* based on the following:

Regarding the first prong, the initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. The examiner recites no evidence or suggestion for using an oral hygiene applicator attachable to the ball of a user's fingertip as "a novelty fashion wear item". The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure [*In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 9Fed. Cir. 1991). The level of skill in the art cannot be relied upon to provided the suggestion to combine references {*Al-Site Corp. V. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)}. Thus Applicant respectfully asserts that there is no suggestion from combining elements from the *Porcellini reference* even in the present application. Accordingly, the present office action of citing *Porcellini reference* does not support the first prong of a proper *prima facie* case of obviousness.



Regarding the second prong, Applicant can find no discussion of the likelihood of success (as found in the prior art) in the present office action of September 7, 2005, which is the first time the examiner has presented the ***Porceilli reference*** as relevant prior art, and therefore Applicant respectfully asserts that the office action does not support the second prong for a proper prima facie case of obviousness.

Regarding the third prong, even when the elements of the ***Porceilli reference*** are combined, the ***Porceilli reference*** does not anticipate every element of Applicant's invention as claimed in claim 1 (as previously presented). Claim 1 as previously presented combines "a flexible pad having a planar body engaging surface and an attachment engaging surface...where the attachment engaging surface is covered with a layer of either hooks or piles for providing the pad with a decorated textured finish." Thus, Applicants invention provides elements which are not suggested nor taught by the ***Porceilli reference***. In summary then, the ***Porceilli reference*** does not consider the elements of claim 1 as previously presented.

More specifically, the examiner has not cited any motivation set forth in the ***Porceilli reference*** or in knowledge generally available to one of ordinary skill in the art, to modify the ***Porceilli reference*** as proposed or suggested by the examiner. The examiner has simply made the conclusory statement that the ***Porceilli reference*** could be utilized "as a fashion wear item for the body".

Applicant further traverses the rejection because claim 1 as previously presented and its dependent claims 5, 13, 14, 15, 18, and 21 as previously patentably distinguish over the ***Porceilli reference*** because claim 1 as previously presented emphasized the novel features of the present invention. In this regard, claim 1 as previously presented specifies amongst other things, as follows:

"1. A novelty fashion wear item, comprising:

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a flexible pad having a planar body engaging surface and an attachment engaging surface;

wherein said planar body engaging surface is coated throughout with reusable adhesive means for removably securing said pad to a body part; and

wherein said attachment engaging surface is covered throughout with a layer of either hooks or piles for providing said pad with a decorated textured finish."

The novel features of the present invention are not disclosed, nor suggested by the ***Porceilli reference*** in that the ***Porceilli reference*** does not disclose, nor suggest a "a flexible pad having a planar body engaging surface and an attachment engaging surface ... ". In this regard, ***Porceilli reference*** states,

"Dental hygiene applicator 10 is constituted by a flexible circular base 11 fabricated of woven nylon or other synthetic plastic or natural fibers on which is anchored a dense circular array of upwardly-projecting bristles." (see Col. 3, lines 45-49).

The ***Porceilli reference*** further states, "Each bristle 12, is formed by a multi strand loop created by fine filaments of nylon or similar material which are interwoven with base 11 to define a three-dimensional minute bulb...in each bulb forming a bristle 12 is a dentifrice 13 in a viscous paste form which is entrapped within the strands that define the bulb." Col 3, lines 49-56. In short, the base 11 is "anchored a dense circular array of upwardly-projecting bristles" which are filled with "a dentifrice in a viscous paste form" clearly teaching away from an "attachment engaging surface" as provided by claim 1 as previously presented. In this regard, the ***Porceilli reference*** clearly teaches that the bulb like surface functions "as scoops, they act to capture food particles and other debris." See Col 2, lines 39-41.

In short then, ***Porceilli reference*** does not suggest not teach, "A novelty fashion wear item, comprising: a flexible pad having a planar body engaging surface and an attachment engaging surface".

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Secondly, the ***Porceilli reference*** does not teach, nor suggest, "wherein said planar body engaging surface is coated throughout with reusable adhesive means for removably securing said pad to a body part..." Instead, the ***Porceilli reference*** as noted above includes bulbs that scoop and collect dirty, bacterial filled debris within the mouth of a user. In this regard, the pad would not be reused but instead would be thrown away for health and safety reasons. In short, the ***Porceilli reference*** teaches away from "reusable adhesive means" for the reasons stated above, and since the abstract teaches that the applicator is a disposable application and is completely silent relative to re-using the applicator after a first use.

Finally, the ***Porceilli reference***, does not suggest, nor disclose, "wherein said attachment engaging surface is covered throughout with a layer of either hooks or piles for providing said pad with a decorated textured finish." Clearly the ***Porceilli reference*** does not teach a "fashion wear item" nor "a decorated textured finish".

Thus, while the ***Porceilli reference*** may a disposable oral hygiene applicator with paste filled bulbs on one of its surfaces, the ***Porceilli reference*** does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 1 as amended, patentably distinguishes over the ***Porceilli reference***.

Claims 5, 13-18 and 21 as well as claims 22-24, and 26-29 each depend from claim 1 and therefore patentably distinguish over the ***Porceilli reference*** under the same rationale as set forth relative to claim 1.

#### **Previously Submitted Amendment**

Applicant with regard to this submission under 37 CFR 1.114 specifically requests the non-entry of the previously submitted Amendment After Final Rejection, filed on November 7, 2005.

### Conclusion

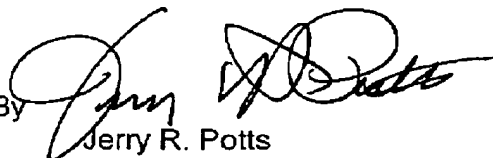
Attorney for Applicant has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Jerry R. Potts, Esq. at the below-listed telephone number.

Dated: November 27, 2005

Respectfully submitted,

Jerry R. Potts & Associates

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Docket No. 810101-3 Holden

11/27/2005 Version A XXXXXXXXXX

